

Appl. No. 09/397,455

Attorney Docket: 042390.P6764

**REMARKS**

The above referenced patent application has been reviewed in light of the Office Action, dated June 24, 2005, in which:

- claims 1, 2, and 4-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Grimmer (US Patent No. 5,774,552) in combination with Van Oorschot (US Patent No. 6,215,872 B1).

Reconsideration of the above referenced patent application in view of the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 1 month(s), including the appropriate fee, is filed herewith.

Claims 1, 2, & 4-26 are now pending the above referenced patent application. No claims have been amended, cancelled, or added.

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# 1. 35 U.S.C. § 103(a)

## 1.1. *Grimmer and Van Oorschot: Claims 1, 2, and 4-26*

The PTO has also rejected claims 1, 2, and 4-26 under 35 U.S.C. § 103(a) based upon Grimmer in combination with Van Oorschot. The rejection of these claims is respectfully traversed.

M.P.E.P. § 706.02(j) sets forth the standard for a § 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (whitespace added).

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

Applicant begins with claim 1. Claim 1 recites:

- 1 1. (Previously Presented) A method comprising:
- 2 reading from a software module embedding one of a set of key associated with a
- 3 trusted source;
- 4 determining whether a key is traceable to one of the set of keys;
- 5 determining whether the key is identified in a list of compromised keys; and
- 6 if the key is not identified as compromised and is traceable to one of the keys in
- 7 the set, assigning the key a trusted status.

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Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Grimmer nor Van Oorschot, either alone or in combination, suggests or describes all the elements and limitations of claim 1.

As stated in the reply to the April 19, 2004 Office Action, Grimmer does not show, teach, use, or describe a reading from a software module embedding one of a set of key associated with a trusted source. Grimmer instead shows reading a set of keys from a database (the Certificate Authority, or LDAP of Fig. 6). It is respectfully asserted that Grimmer shows using a software module to perform encryption.

Applicant respectfully asserts that the public keys of Grimmer and Van Oorschot are not embedded within a software module. Grimmer instead shows the public key being stored within an external database. See Column 6, lines 36-38, and Fig. 6.

Applicant respectfully asserts that Van Oorschot does not ameliorate this deficiently. Van Oorschot instead shows public keys stored within a database, which is accessed by the security manager (software module). Applicant respectfully asserts that Figure 1 of Van Oorschot clearly shows that the security managers (Fig. 1, elements 12-16) are separate and distinct from the database directory (Fig. 1, element 18). It is also noted that Van Oorschot describes the security managers as separate "personal computers" that share the common directory. (See, Col. 3, lines 60-67.) Therefore, the common directory can not be embedded within each of the security managers.

In the June 24, 2005 office action the PTO stated that "features upon which applicant relies ... are not recited in the rejected claims." Applicant respectfully disagrees.

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The PTO states "The limitation does not clearly point out ... that the key is read from the software module." Applicant respectfully notes that claim 1, line 2 clearly states "reading from a software module." Applicant is unsure of how to reword the claim in order to make this clearer. In fact, the PTO uses the exact same words (allowing for "read" versus "reading") to describe the limitation. Applicant asserts that the clear plain meaning of the cited phrase leaves little doubt that the limitation is "reading from a software module" and that no interpretation of the specification is needed. Applicant respectfully asserts that, as described above, this unmet limitation alone is sufficient to illustrate that the combination fails to produce the invention as recited in the rejected claims.

The PTO has also stated that "The limitation does not clearly point out that a key is embedded within a software module ...". The PTO further suggests that the claim suggests two distinct operations (1) reading from a software module, and (2) embedding a key. See the June 2005 Office Action, page 2, lines 17-20. Applicant respectfully disagrees.

For convenience, Applicant repeats claim 1. Claim 1 recites:

- 1 1. (Previously Presented) A method comprising:
- 2 reading from a software module embedding one of a set of key associated with a
- 3 trusted source;
- 4 determining whether a key is traceable to one of the set of keys;
- 5 determining whether the key is identified in a list of compromised keys; and
- 6 if the key is not identified as compromised and is traceable to one of the keys in
- 7 the set, assigning the key a trusted status.

Applicant asserts that using a plain meaning approach the element of lines 2 & 3 is clearly one step. If it was two separate steps there would be a semicolon separating the steps as seen by the transition of the elements of line 3 to line 4, line 4 to line 5, and line 5 to line 6. A semicolon is used to connect independent clauses; therefore, if "reading" and "embedding" are not separated by a semicolon they must be dependent upon each other. Furthermore, each of

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these new, separate, and distinct elements (see the line citations above) are separated by a semicolon, a line break, and indentation. None of these three transitional devices separate the word "module" from the word "embedding" in line 2; therefore, it is asserted that a proper reading of the element leads one to believe that it is one element not two as suggested by the PTO.

Furthermore, if the key is read "from a software module" (as opposed to "by a software module") logic dictates that the key must be contained within the software module. If the key is not within the software module, it is not possible to read the key from the module. Therefore, reading the claim using nothing more than the logical plain meaning of the terms (as required by M.P.E.P. § 2111) leads one to understand that the key, which is read from the module, is embedded within the module. Once again, no interpretation of the specification is needed. Applicant respectfully asserts that, as described above, this unmet limitation alone is sufficient to illustrate that the combination fails to produce the invention as recited in the rejected claims.

Therefore, even if the combination were proper, although Applicant believes that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

Claims 2 and 4-26 either depend from and include the limitations of claim 1, or include a substantially similar and patentably distinct limitation as claim 1. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 1. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

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**CONCLUSION**

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,



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